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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/834,226 | 04/12/2001 | Marko Cencur | 11658/9-1380 | 3358 |

28147 7590 08/20/2003

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| EXAMINER |
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TOATLEY, GREGORY J

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| ART UNIT | PAPER NUMBER |
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2836

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/834,226 | CENCUR, MARKO |
| | Examiner Gregory J. Toatley, Jr. | Art Unit 2838 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 June 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 19-25 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,4,5,8,11,18 and 26 is/are rejected.
- 7) Claim(s) 3,6,7,9,10 and 12-17 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 April 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 – 18 and 26, drawn to a non-contact (i.e. proximity switch), classified in class 307, subclass 116.
 - II. Claims 18 - 25, drawn to an illumination control system, classified in class 323, subclass 905.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because any type of contact switch would meet the limitations claimed. The subcombination has separate utility such as make or breaker for a power distribution system in a home.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with William Sapone on July 28, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18 and 26. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 19-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

DETAILED ACTION

Information Disclosure Statement

5. The information disclosure statement received December 10, 2001 has been considered and entered into the application. See attached 1449.

Specification

6. The examiner respectfully suggests that the Applicant carefully review the specification for idiomatic and grammatical errors, which may have inadvertently overlooked.

Art Rejection Rationale

At the outset, the examiner notes that claims are to be given their broadest reasonable interpretation during prosecution. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969); In re Yamamoto, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984); Burlington Indus. V. Quigg, 822 F.2d 1581, 3 USPQ2d 1436 (Fed. Cir. 1987); In re Morris, 43 USPQ2d 1753, 1756 (Fed. Cir. 1997). In responding to this Office action, applicants are reminded of the requirements of 37 CFR §§ 1.111 and 1.119 that applicants specifically point out the specific distinctions believed to render the claims patentable over the references in presenting responsive arguments. See M.P.E.P. § 714.02. The support for any amendments made should also be specifically pointed out. See M.P.E.P. § 2163.06.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, 5, 8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by the reference of Suzuki et al. (US 6376939 B1). The reference discloses:

(From Claim 1) A compact non-contact electrical switch (Fig. 1, system (24)) for use in an electrical box mountable in a wall and having an electrical circuit passing therethrough (the “for use...therethrough” limitations amounts to the intended use of the switch and is not considered to further limit the scope of the claim) comprising:

means (elements 26, 16 and 18) for detecting a presence of an object adjacent to the switch and for generating an output signal;

a central processing unit (74) connected to the presence detecting means and having means (interface circuit (70)) for receiving the output signal therefrom, and having signal processing means for calculating a power output in response to the output signal for generating a control signal for controlling power supplied to the electrical circuit (see col. 8, lines 30 – 59).

(From claim 2) The switch of claim 1 wherein the detecting means is a capacitive sensor.

(From claim 5) The switch of claim 1 further comprising an A/D converter to convert the output signal from the detecting means to a digital value (col. 8, line 35).

(From claim 11) The switch of claim 1 further comprising a power supply (54 and 56) for the switch.

Regarding the amount of power being supply being a function of the output signal, this is an inherent function of the system in that when the output signal is not provided or zero, not

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power is provided to the driver and when the output signal is provided power is provided to the driver.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference of Suzuki et al. The reference of Suzuki et al. is silent regarding the use of an relay as an activation/deactivation element for the system although an output to a driving system is shown. The examiner wishes to take Official Notice of the fact that the use of a relay and a relay driver in order to activate or deactivate an electrical system is well known. It would have been obvious to one having ordinary skill in the art to use a relay as the activation/deactivation element in the invention of Suzuki et al. in order to provide a means to positively turn the system off when the drive signal is provided.

11. Claims 18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference of Suzuki et al. as applied to claim 1 above and in further combination with the reference of Kunen et al. (US 5716129 A). The reference of Suzuki et al. is silent regarding the use of the proximity sensor in an illumination system. The reference of Kunen et al. teaches of the use of a proximity sensor in an illumination system (see fig. 1). It would have been obvious to one having ordinary skill in the art have been obvious to one having ordinary skill in the art at the time of invention to use the disclosed proximity switching system of Suzuki et al. with a illumination system as suggested by Kunen et al. order to

provide a means to turn on or off a light without the use having to physically touch a switch which is mechanically subject to wear.

Regarding the claim 26, the reference of Suzuki teaches the claimed method of operating a device as claimed, except for the provision of the system in a box. The reference of Kunen et al. suggests that a proximity sensor system can be placed in an enclosure. It would have been obvious to one having ordinary skill in the art to enclose the system of Suzuki et al. in order to provide a system that is not exposed to the elements that would degrade its function over time.

12. Several facts have been relied upon from the personal knowledge of the examiner about which the examiner took Official Notice. Applicant must seasonably challenge well known statements and statements based on personal knowledge when they are made by the Board of Patent Appeals and Interferences. *In re Selmi*, 156 F.2d 96, 70 USPQ 197 (CCPA 1946); *In re Fischer*, 125 F.2d 725, 52 USPQ 473 (CCPA 1942). See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice). If applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well-known statement was made. See MPEP 2144.03, paragraphs 4 and 6.

Allowable Subject Matter

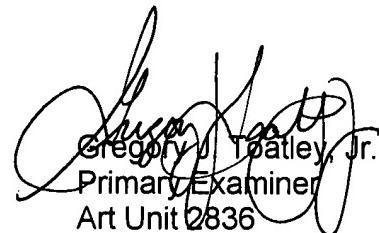
13. Claims 3, 6, 7, 9, 10, 12 – 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: Prior art of record does not teach or suggest the AC zero cross detector as claimed in claim 3; the differentiator of claim 6, the comparator of claim 7, the delay counter of claim 9, the signal variance as claimed in claim 10, the semi-conduction element of claim 12, the air gap switch of claim 14.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Toatley, Jr. whose telephone number is 703-308-7889. The examiner can normally be reached on Mon. - Thurs. 6:30 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (703) 308-3119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.



Gregory J. Toatley, Jr.
Primary Examiner
Art Unit 2836

GJT Jr.
August 11, 2003